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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,054	10/31/2003	Kazuki Emori	SHO-0038	8377

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EXAMINER

SAVIC, BORIS

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/697,054	EMORI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Boris Savic	3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/26/2004, 10/22/2004, and 5/5/2005.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10697007. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of them talk about game result display means for displaying a game result thereon; and beneficial state generating means for generating a beneficial state for a player; and wherein the game result display means includes first display means and second display means arranged at a more front side than a display area of the first display means when seen from a front side of the gaming machine.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Title Objections***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Objections***

4. Claim 4 is objected to because of the following informalities: In claim 4 says, "The gaming machine according to claim 4, wherein the liquid crystal panel is set to normally white." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 recites the limitation "according to claim 4" in the gaming machine, wherein the liquid crystal panel is set to normally white. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Masaaki Ozaki et al. (US 2001/0031658 A1).

Regarding claims 1 and 2, Ozaki discloses the slot machine 15 has a front frame 11 to which a panel 6 is attached. A transparent EL panel, 5 is attached to the back surface of the panel 6, which corresponds to a front display means (display unit). A rotational reel display device 2 is disposed at the back side of the transparent EL panel 5. A fluorescent lamp 9 is disposed inside the front frame 11 at an obliquely upper position of the EL panel 5, and illuminates the reels 2a. (See page 8, paragraphs 112 and 113) As shown in Fig. 27, a transparent liquid crystal shutter 23 may be disposed in the space between the back side display means 2 (rotational reel display device) and the front side display means 5. (See page 10, paragraph 137) A game machines has a back side display unit composed of reels for displaying back patterns, and a front side display unit composed of transparent EL panels for displaying overlapping patterns overlapping with the back patterns. (See Abstract)

Regarding claim 5, Ozaki discloses the combination of the back patterns 31 determined by the stop pattern selection means 50d is a winning condition, a determination (reel determination) is made whether the winning combination is displayed by the already stopped reels 30a, 30b, and 30c. If the winning combination is not displayed by the back patterns 31 despite the fact that it is selected as a winning combination by the lottery, the CPU 51 makes the transparent EL panels 28a, 28b, and 28c display the overlapping patterns 32 to display the winning combination in coordination with the back patterns 31 and the overlapping patterns 32 (s107). (See page 5, paragraphs 73 and 74) In case where winning combinations are displayed by the combinations of the back patterns 31 and the overlapping 32, it is possible to set up

in a such a way that a winning display is effectuated by a combination of the back patterns 31 and the overlapping patterns 32 only when a pair of identical patterns of the back patterns 31 and the overlapping patterns 32 exists. The winning condition is established by the combination of the overlapping patterns 32 and the back patterns 31 only when the display content of the transparent EL panels 28a, 28b, 28c or the relation between the overlapping patterns 32 and the back patterns 31 meet a certain preset condition. The front/back combination-permitting condition is not limited to a specific one, but may be preset arbitrary. (See page 5, paragraphs 78 and 79)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki in view of Shingo Shimizu et al. (US 6,398,217 B1).

Ozaki teaches the spontaneous luminescent display device such as an EL display device, the display device is controlled to be brighter or darker by an ON-OFF control for supplying electricity to the device. The visibility of the luminescent display device through the front side display means changes in response to that control. As shown in Fig. 27, a transparent liquid crystal shutter 23 may be disposed in the space between the back side display means 2 (rotational reel display device) and the front side display means 5. As shown in FIG. 28, a semi-transparent reflective plate 25 is

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disposed between a transmission type (transparent) LCD device 24 and the back side display device (rotational reel display device) 2. A light source 26 for the LCD device 24 is preferably disposed upward of the reflective plate 25, and the light source 9 for the back side display device 2 is preferably disposed at the back side of the reflective plate 25. Accordingly, light emitted from the light source 9 is reflected by the back side display device 2 and passes through the reflective plate 25, while light emitted from the light source 26 is reflected by the reflective plate 25. Then, the player recognizes both lights through the LCD device 24. (See pages 10-11, paragraphs 136-138) Ozaki does not teach a plurality of symbol display parts. Shimizu teaches the display mode includes a special symbol for informing that the game condition is transferred to the specified game condition by showing a predetermined stop state when a symbol variation is stopped, and a predetermined symbol for predicting the stop state of the special symbol. The predictive symbol is provided as plural kinds of symbols having respective relationship. (See Abstract) Therefore, it would have been obvious to one in ordinary skill in the art at the time of the invention to combine the LCD device with the gaming machine with the video display that displays the predictive symbol that is provided as plural kinds of symbols having respective relationship on a plurality of reels. Reason for that is because the picture of the rotating reels on the gaming machine display would be more visible, sharper, and clear if used with LCD device.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki in view of Nicholas Luke Bennett (US 6,251,013 B1).



Ozaki teaches the slot machine 15 that has a transparent EL panel, 5 is attached to the back surface of the panel 6, which corresponds to a front display means (display unit). A rotational reel display device 2 is disposed at the back side of the transparent EL panel 5. A fluorescent lamp 9 is disposed inside the front frame 11 at an obliquely upper position of the EL panel 5, and illuminates the reels 2a. (See page 8, paragraphs 112 and 113) Ozaki does not teach the illumination means able to variably display the symbols. Bennett teaches a gaming machine having a display and game control, the game control being arranged to play a game wherein a plurality of symbols are randomly selected from a predetermined set of symbols and displayed in rows on the display and if a winning combination of symbols results, the machine pays a prize. (See Abstract) Referring to Fig. 1, the first embodiment of the invention is illustrated in which a slot machine 10, of the type having a video display screen 20 which displays a plurality of rotatable reels 30 carrying symbols 40, is arranged to pay a prize on the occurrence of a predetermined symbol or combination of symbols. (See col. 3, lines 46-51) This means that the illumination means or display means is able to variably or randomly display the symbols on the rotating reels. Therefore, it would have been obvious to one in ordinary skill in the art at the time of the invention to add the feature of randomly displaying the symbols on the rotating reels of the gaming machine because it would make the gaming machine, slot machine, harder to beat, more entertaining, and it would bring more customers, which means more money.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Savic whose telephone number is (571) 272-2849. The examiner can normally be reached on Monday - Friday, 6:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TC3700